

REMARKS

The Official Action mailed July 23, 2004, has been received and its contents carefully noted. This response is filed within three months of the mailing date of the Official Action and therefore is believed to be timely without extension of time. Accordingly, the Applicants respectfully submit that this response is being timely filed.

The Applicants note with appreciation the consideration of the Information Disclosure Statements filed on July 20, 2001, and April 21, 2004.

Claims 1-13 were pending in the present application prior to the above amendment. Claims 6-8 have been canceled, and independent claims 1-3 and 9 have been amended to better recite the features of the present invention. Accordingly, claims 1-5 and 9-13 are now pending in the present application, of which claims 1-3 and 9 are independent. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

The Official Action rejects claims 1-13 as obvious based on the combination of Japanese Kokai Patent Application No. Sho 60[1985]-243730 to Toru Sakon et al. (Toru). The Applicants respectfully submit that a *prima facie* case of obviousness cannot be maintained against the independent claims of the present application, as amended.

As stated in MPEP §§ 2142-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in

the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The prior art, either alone or in combination, does not teach or suggest all the features of the independent claims, as amended. Independent claims 1-3 and 9 have been amended to recite that an operator can specify an action without seeing a screen by using movement between two end portions or a start position and a termination position, which is supported in the specification, for example, at page 27, paragraph [0070]. Toru does not teach or suggest at least the above-referenced features of the present invention. Since Toru does not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained.

Furthermore, there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Toru to achieve the claimed invention. MPEP § 2142 states that the examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. It is respectfully submitted that the Official Action has failed to carry this burden. While the Official Action relies on various teachings of the cited prior art to disclose aspects of the claimed invention and asserts that these aspects could be modified in the manner asserted in the Official Action, it is submitted that the Official Action does not adequately set forth why one of skill in the art would modify the reference to achieve the features of the present invention.

The Official Action concedes that Toru does not teach "the end portions located at four corner areas of said touch panel" (page 3, Paper No. 5). The Official Action asserts that "it would have been obvious to a person of ordinary skill in the art to modify the start and end points of the track of the finger moved by the user as taught by the

prior art to achieve the end portions located at four corner areas of said touch panel because this would provide a method in which direction information can be input using an image almost identical to the one the user images" (Id.). The Applicants respectfully disagree and traverse the above assertions in the Official Action.

In Toru, the direction information is identified based on an angle created by a straight line connecting start and end points and a reference axis of a touch panel and relative positions of the two points. Thus, a very short movement of an operator's finger on the touch panel is sufficient in the practice of Toru's invention.

The present invention is directed to an apparatus comprising a specifying means that detects a contact point moved from one end portion of a touch panel to another end portion, with the end portions located at four corner areas of the touch panel or along a peripheral portion of a display screen, on the basis of positional information, and an action commanded by an operator is specified from a movement start end portion and a movement termination end portion of the detected contact point, so that the operator can specify the action without seeing the screen by using the movement between the two end portions or between the start and termination positions. In other words, movement from the four corner areas of the touch panel or along a peripheral portion of a display screen is essential to the practice of the invention as it allows an operator to operate the device tactically or "by feel." An operator feels the four corners or the peripheral portion of the display and may command an action by interacting with these portions of the display.

In contrast, Toru simply relates to the calculation of an angle in order to enable page flipping. Toru is not concerned with a situation where end portions are located at four corner areas of a touch panel so that an action commanded by an operator is specified based on two end portions or a movement start end portion and a movement termination end portion. Thus, it is unclear why one of ordinary skill in the art would have been motivated to modify Toru to achieve the features of the present invention.

Therefore, there is no teaching or suggestion in Toru that movement at four corner areas of the touch panel or along a peripheral portion of a display screen is necessary.

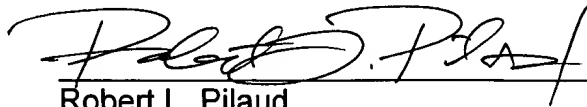
Also, in Toru, a relatively short distance command is all that is necessary or contemplated in order to complete the page flipping command. In contrast, the Applicants' device is adapted to handle a longer distance of the movement of the operator's finger between the two end portions on the touch screen, and since a long pause, such as a pause of two seconds, does not necessarily prompt a new command, the Applicants' device is particularly adapted for use by an operator who is unable to view the touch screen, such as an operator of a motor vehicle (see e.g., page 26, paragraph [0068], and page 27, paragraph [0070]). Thus, in the present invention, by using movement between two end portions of a screen, an operator may specify an action of a device without seeing the screen. Tora is not concerned with these matters; therefore, Tora lacks sufficient motivation to modify the apparatus of Tora such that an operator may specify an action of a device without seeing a screen by using movement between two end portions of the screen.

In the present application, it is respectfully submitted that the prior art of record, alone or in combination, does not expressly or impliedly suggest the claimed invention and the Official Action has not presented a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

For the reasons stated above, the Official Action has not formed a proper *prima facie* case of obviousness. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Robert L. Pilaud", written over a horizontal line.

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